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PATENT APPLICATION

ATTORNEY DOCKET NO. 10013478-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Brett A. Green**

Confirmation No.: 8143

Application No.: 10/005,583

Examiner: Honeycutt, K.

Filing Date: 10-26-01

Group Art Unit: 2178

Title: **Browser-Controlled Scanning System and Method**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 7-19-06.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

Brett A. Green

By

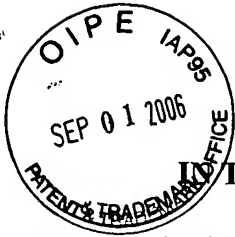
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Brett A. Green

Serial No.: 10/005,583

Filed: October 26, 2001

Confirmation No.: 8143

Group Art Unit: 2178

Examiner: Honeycutt, K.

Docket No. 10013478-1

For: **Browser-Controlled Scanning System and Method**

REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER

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Sir:

The Examiner's Answer mailed July 19, 2006 has been carefully considered. In response thereto, please consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

REMARKS

The Examiner has provided in the Examiner's Answer various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses selected responses in the following.

1. Examiner Arguments Regarding Claim 1

On page 12 of the Examiner's Answer, the Examiner again insists that Kuwata teaches "receiving a scan request from a user browser" and cites paragraphs 41 and 47 of the Kuwata reference for support. Applicant has already reproduced those paragraphs for the Board's consideration in the Appeal Brief and has already identified that neither paragraph contains such a teaching. Therefore, Applicant will not repeat that discussion and instead refers back to the comments provided in the Appeal Brief.

Strangely, the Examiner follows the above argument by admitting what Applicant has argued throughout prosecution and appeal: Kuwata teaches a user scanning a document by utilizing a front panel of Kuwata's "server." *Examiner's Answer*, page 12. Given that admission, it is difficult to understand why the Examiner maintains the rejection. Simply stated, if the scan request is entered by the user with the front panel of Kuwata's server, then Kuwata does not teach "receiving a scan request from a user browser". That Kuwata's server is also "accessible" with a browser does not change that fact because, as stated repeatedly by Applicant throughout prosecution and appeal, Kuwata only describes using a browser to access documents *that already have been scanned*, i.e., *after* the scan request was entered by the user with the front panel.

As a further point, Applicant notes that it appears that Kuwata's written description is misleading and that Kuwata's "server" does not actually comprise a "front panel" at all. Instead,

as is explicitly indicated in Figure 3, Kuwata's "Server" is connected to a stand-alone "Copier/Scanner/Fax/Printer," which is relied upon for performing the scanning. Therefore, although Kuwata implies that a "front panel" of the "server" is used to initiate scanning, it appears that it is the front panel of the "Copier/Scanner/Fax/Printer" in Figure 3 that is actually used to initiate scanning. Assuming that is the case, which is the most logical conclusion given that "servers" typically do not comprise a "front panel," what Kuwata actually teaches is merely scanning a document using a walk-up scanner that happens to be connected to a server. Accordingly, Kuwata teaches a conventional arrangement in which (a) a user can scan a document using a scanner, and (b) later access the scanned document from a computer (Kuwata's server) that is connected to the scanner. Clearly, such an arrangement does not enable "receiving a scan request from a user browser".

On page 13 of the Examiner's Answer, the Examiner disagrees that Kuwata fails to teach "receiving selections made with the user browser" as recited in claim 1. In defending his position, the Examiner points out that Kuwata teaches using a browser to access scanned documents and therefore teaches receiving selections made with the user browser. Applicant agrees that selections are made with a browser when a user accesses scanned documents. However, Applicant objects to the Examiner's piecemeal approach in dealing with the limitations of claim 1. Under the Examiner's analysis, each limitation of Applicant's claim is being considered in a vacuum. As is well established in the law, the Examiner must instead consider the claim as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987)(In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). When Applicant's claim is considered as a whole, it becomes

clear that that the “selections” that are being described are selections pertinent to the scan request described two lines earlier in the claim. To ignore that context is to fail to consider the whole claim as required by the law.

2. Examiner Arguments Regarding Claim 2

In defending the rejection of claim 2, the Examiner argues that Kuwata teaches “uploading logic configured to generate at least one control screen” for display in the user’s browser, and again notes that Kuwata teaches accessing scanned documents with a browser.

In reply, Applicant notes that Kuwata never describes “uploading” any “control screen” to a user browser. Paragraphs 47 and 53 of the Kuwata reference do not, as argued by the Examiner at the top of page 14 of the Examiner’s Answer, say *anything* about such a “control screen”. Moreover, Kuwata’s “folders” identified by the Examiner are not described as comprising “control screens”.

3. Examiner Arguments Regarding Claim 3

The Examiner again argues that Kuwata teaches that uploading content to a user browser comprising “at least one application that is configured to perform a designated task on a computing device” in paragraph 0053.

Applicant replies, as in the Appeal Brief, that although Kuwata describes “enabling tabs or buttons,” Kuwata does not teach uploading any “application” to a user browser. Regarding the Examiner’s argument that “unlocking controls, by enabling tabs and buttons when an Administrator logs in, comprises an application,” Applicant disagrees. Merely “unlocking” a control does *not* require “uploading” and “application” to a browser. For example, a simple command to “unlock” a

control could be sent by Kuwata's server to the browser. Clearly, such a command could not reasonably be considered an "application" that has been "uploaded" to the browser.

4. Examiner Arguments Regarding Claim 21

On page 15 of the Examiner's Answer, the Examiner argues that Kuwata's server is a "scanner" and therefore Kuwata satisfies "wherein the receiving, uploading, and scanning are all performed by a scanning device". As a first matter, Applicant reiterates that Kuwata fails to teach the "receiving" and "uploading" limitations. As to the Examiner's argument that Kuwata's "server" comprises a "scanner", Applicant believes that argument to be untenable. Clearly, a "server" is not a "scanner" any more than a cat is a dog. Although Kuwata's disclosure lacks explicit written description as to which component actually performs the scanning in the Kuwata system, the reasonable conclusion is that scanning is performed by a scanner that is *connected to* the server. As identified above, that conclusion is supported by Figure 3, which explicitly shows a "Copier/Scanner/Fax/Printer" that is *connected to* Kuwata's "Server."

5. Examiner Arguments Regarding Claim 9

In discussing claim 9, the Examiner reiterates the same arguments made in relation to claim

1. Applicant replies by referring to the discussion of claim 1 in the foregoing.

6. Examiner Arguments Regarding Claim 22

In discussing claim 22, the Examiner reiterates the same arguments made in relation to claim 21. Applicant replies by referring to the discussion of claim 21 in the foregoing.

7. Examiner Arguments Regarding Claim 13

In discussing claim 13, the Examiner reiterates the same arguments made in relation to claim 1. Applicant replies by referring to the discussion of claim 1 in the foregoing.

8. Examiner Arguments Regarding Claim 15 and 23

In discussing claims 15 and 23, the Examiner reiterates the same arguments made in relation to claims 3 and 21. Applicant replies by referring to the discussions of claim 3 and 21 in the foregoing.

9. Examiner Arguments Regarding Claim 4

On page 20 of the Examiner's Answer, the Examiner argues that Kuwata teaches "uploading" an "application" to a user browser and reiterates the arguments the Examiner made in relation to claim 3. In reply, Applicant reasserts that Kuwata fails to teach such uploading, and refers to the discussion of claim 3 in the foregoing. Given that Dance does not teach uploading any applications to a user browser (the Examiner makes no arguments that Dance teaches such an action), it follows that the Kuwata/Dance combination fails to render claim 4 obvious.

10. Examiner Arguments Regarding Claim 5

On page 21 of the Examiner's Answer, the Examiner again argues that that Kuwata teaches "uploading" an "application" to a user browser and reiterates the arguments the Examiner made in relation to claim 3. In reply, Applicant reasserts that Kuwata fails to teach such uploading, and refers to the discussion of claim 3 in the foregoing.

In addition to failing to teach uploading an “application”, it is further clear that Kuwata does not teach uploading an application that “is configured to locate an optical character recognition module of a computing device”. As to that limitation, there is *absolutely nothing* in the Kuwata disclosure that is even remotely close to a teaching of uploading an application to a user browser that is “configured to locate” another program, whether it be an optical recognition program or other program. The Examiner’s discussion of “unlocking controls” is completely irrelevant to that aspect of claim 5.

Finally, as noted above, Dance does not teach uploading any applications to a user browser, and the Examiner makes no arguments that Dance teaches such an action. It therefore follows that the Kuwata/Dance combination fails to render claim 5 obvious.

11. Examiner Arguments Regarding Claims 10 and 14

Next, on page 22 of the Examiner’s Answer, the Examiner argues that Kuwata teaches an “embedded server” that comprises “means for uploading content to the user browser”.

In reply, Applicant again notes that while Kuwata generally speaks of a “server,” the Kuwata system actually comprises a “Server” and a separate “Copier/Scanner/Fax/Printer”. See *Kuwata*, Figure 3. The “Server” is clearly a server computer, and is not “embedded” in any other device. As is well known to persons having ordinary skill in the computing arts, “embedded servers” are software-based modules that are executed by a host machine, such as a PC or printer, and serve information to a requesting device. That fact is supported by the Somashekar reference.

Regarding the Examiner’s apparent argument that it would have been obvious to provide an “embedded server” within Kuwata’s server, Applicant asserts that such an argument makes

little sense. By analogy, that argument is equivalent to saying that it would be obvious to set up a Starbucks within a Starbucks. No person having ordinary skill in the art would reasonably think to embed a server within a server.

12. Examiner Arguments Regarding Claim 17

On page 24 of the Examiner's Answer, the Examiner argues that Kuwata teaches a "scanning device" that comprises a scan control module and an embedded server.

In reply, Applicant reiterates that Kuwata does not actually teach a "scanning device" that comprises an embedded server. Again, Kuwata teaches a "Server" and a connected "Copier/Scanner/Fax/Printer" that performs scanning. *See Kuwata*, Figure 3. Nowhere, however, does Kuwata state that the "Copier/Scanner/Fax/Printer" comprises an "embedded server". Indeed, Kuwata says nothing at all about the "Copier/Scanner/Fax/Printer" of Figure 3.

Furthermore, the argument that it would have been obvious to add an embedded server to Kuwata's "Copier/Scanner/Fax/Printer" is unwarranted because, as described and shown by Kuwata, an actual server computer is already provided in the Kuwata system for providing access to documents scanned by the "Copier/Scanner/Fax/Printer". Therefore, there is simply no need for an "embedded server" in Kuwata's system.

As a further point, Kuwata does not describe uploading a "control screen" used for scanning, for reasons described above in relation to claim 2.

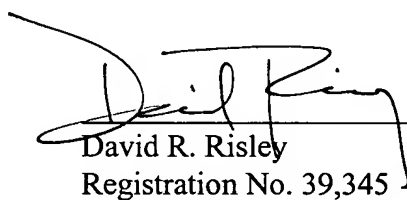
13. Examiner Arguments Regarding Claims 18, 19, and 20

On page 26 of the Examiner's Answer, the Examiner presents the same arguments the Examiner presented as to the issue of "uploading" an "application" to a user browser. In reply, Applicant refers to the discussions

CONCLUSION

In summary, it is Applicant's position that Applicant's claims are patentable over the applied prior art references and that the rejection of these claims should be withdrawn. Appellant therefore respectfully requests that the Board of Appeals overturn the Examiner's rejection and allow Applicant's pending claims.

Respectfully submitted,


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Registration No. 39,345

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May M. Lefer
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